REMARKS

Claims 1-13 were originally filed in the present application. Claim 2 has been previously cancelled, and Claims 14-16 were previously added, making Claims 1 and 3-16 at issue. Of the remaining claims, Claims 1 and 14 have been amended. The term "all" has been added to the step of "automatically retrieving" as set forth in each of the independent claims. No new matter has been added to the claims.

The Office Action of November 30 (hereinafter "Action") has rejected Claims 1 and 3-16 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,740,729 to Klein et al. (hereinafter "Klein") in view of U.S. Pre-Grant Publication No. 2003/0018659 to Fuks et al. (hereinafter "Fuks"). Applicant respectfully traverses this rejection and requests reconsideration in light of the amendments above and the remarks below.

Under §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which [it] pertains." 35 U.S.C. 103(a).

Claims 1 and 14-16 are each independent, with Claims 3-13 depending from Claim 1. Independent claims 1 and 14, as amended, require the steps of "associating said initial search term to all topical categories related to said initial topical category" and "automatically retrieving said document information of all said documents assigned to said related categories." Claims 15 and 16 require the steps of "associating the initial search term to any topical categories related to said initial topical category" and "automatically retrieving" document information of any

documents assigned to any related categories, either "irrespective of a relevancy" (Claim 15) or including those documents "which are not relevant" (Claim 16).

A previous PTO Action acknowledged that Klein does not disclose "associating said initial search term to all topical categories related to said initial topical category. . . ." That acknowledgement is repeated in the present Action. Therefore, such a step must be found in another reference, **and** a motivation must exist or a teaching provided which would lead one of skill in the art to combine the teachings of the references to achieve the present invention.

Applicant traverses the present 103(a) rejection on the grounds that neither of the cited references discloses the steps of (1) associating said initial search term to any topical categories related to said initial topical category thereby creating related categories, or (2) automatically retrieving document information from any and all documents assigned to topical categories related to an initial topical category. The examiner again states for the record:

> Klein [does not disclose]: associating said initial search term to any topical categories related to said initial topical category thereby creating related categories; [or] associating said initial search term to all topical categories related to said initial topical category thereby creating related categories.
>
> However, the Action points to Fuks as disclosing:
>
> Associating said initial search term to any topical categories related to said initial topical category thereby creating related categories (paragraph 0084, Fuks); associating said initial search term to all topical categories related to said initial topical category thereby creating related categories (fig. 4 and 0084, Fuks).

This is not an accurate statement of the Fuks disclosure. Rather, Fuks discloses a method which searches through all documents based on an initial query, then based on the number of documents retrieved from each of a group of pre-selected categories, the categories are scored and ranked as to their relevance to the initial search query. For example, Fuks (with reference to

paragraph 0084, specifically cited in the present Action) uses the term "smoking" to retrieve 2,270 documents assigned to 6 categories. However, the 6 categories "were chosen from the list of categories according to their relevancy" **to the initial query**. The "Behavioral Health" category, for example states Fuks, is displayed because it is "very relevant for the 'smoking' query…." Accordingly, the initial search term is not associated to any or all topical categories related to the initial topical category to create related categories, as alleged in the current Action. Rather, some (though not "any" and certainly not "all") categories are selected as being directly related to the initial search term (see paragraphs 0058 through 0068). From these categories, a relevancy ranking is prepared. At no point are categories related to one another, except through their relevance to the initial query. This defeats the purpose of obtaining a more diversified search result.

Further, the examiner suggests that Klein/Fuks disclose: "automatically retrieving document information of said documents assigned to the related categories" and then "displaying said retrieved document information." This is also an inaccurate statement.

As previously stated, the present claims require one of either the step of:

> automatically retrieving said document information of all said documents assigned to said related categories (Claims 1 and 14);

or

> automatically retrieving said document information of any said documents assigned to any said related categories, irrespective of a relevancy between said initial search term and any said related categories (Claims 15 and 16).

Again, Fuks performs a search based on the query (e.g., "smoking") and then selects categories based on the categories of the documents retrieved. There is no disclosure within Fuks which would teach one of skill in the art to display any and all documents. In fact, Fuks

notes, with respect to one example (paragraph 0079), only 422 documents are retrieved, while the category actually includes 20,000 documents.

Further, Claims 15 and 16 specifically call for the retrieval and display of documents "irrespective of a relevancy between the initial search term and any said related categories." Fuks, and all other cited references, are about relevancy. That is, the documents are scored as to their relevance to the initial query (see paragraphs 0058 and 0059). Based on the collective relevance of the documents within a category, the category is scored for relevancy to the query as well. Only the most relevant categories are displayed in the search results (paragraph 0081).

As previously pointed out, the claimed method is not an invention where one reference can possibly disclose the first 10 steps and a second reference the next three steps. Rather, the claimed steps are a logical progression to achieve an end result, with each step reliant on the presence and completion of the previous step. If a reference does not teach the first step—"providing a topical category . . . ." in the case of Claim 1—then it cannot teach the second step, which depends on the presence of the first step. The Action, ignoring this logical progression and attempting to improperly piece together two references, admits by its stated rejection that neither reference teaches all the required steps of the claimed invention.

Both Klein and Fuks teach a method of retrieving relevant information categories. The system disclosed in Klein contains a database having a plurality of categories, which are inter-related in a familial structure. After the system receives a user search query, in the form of a search term query, a category most relevant to the user search query is selected and designated the "seed category." (Klein, Col. 8, lines 51-55). The system then builds a cluster of ancestor and descendent categories around the seed category. (Klein, Col. 10, lines 37-39). The cluster

of ancestor and descendent categories may include a grandparent, parent, child and sibling, or any combination thereof. (Klein, Col. 10, lines 40-42). Klein only selects and displays individual categories of the cluster of categories based upon the individual categories' relevance with the queried search term. (Klein, Col. 12, lines 36-42). Accordingly, each category that is displayed in Klein must be relevant to the queried search term. (Klein, Col. 10, line 66 - Col. 11, line 2; Col. 12, lines 55-57).

Fuks, as explained in detail above, is directed to a method for scoring indexing concepts (i.e., categories) for their relevancy to an initial query. A collection of documents is obtained and classified to a set of indexing concepts, which are then scored according to their relevance to the collection of documents. The categories or concepts are never related to one another as required by the claims ("relating each of said topical categories with other said topical categories contained within said topical category database"). Absent this step, it is unclear how the Action can contend that Fuks associates the initial search term to any or all topical categories related to said initial topical category thereby creating related categories. Again, none of the categories are ever related to one another.

No combination of the cited references could suggest the claimed features of the present application, as the Examiner alleges. *See In re Rouffet*, 149 F.3d at 1356 (differences between the combined prior art and the claimed invention cannot show a *prima facie* case of obviousness). The only suggestion of these features is found in the present application and while, in hindsight, it may now appear to be simple or elementary, that is not the test for obviousness or non-patentability. *Crown Operations, Ltd. v. Solution, Inc.*, 289 F.3d at 1376 ("Determination of obviousness cannot be based on the hindsight combination of components

selectively culled from the prior art to fit the parameters of the patented invention."); *see also In re Laskowski*, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); *In re Rouffet*, 149 F.3d at 1357-58. Accordingly, Applicant contends that Claims 1 and 14-16, and the claims that depend therefrom, distinguish over Klein and Bailey, either considered alone or in combination. Reconsideration is respectfully requested.

CONCLUSION

Claims 1 and 3-16 are currently pending in the present application. All claims have been rejected as unpatentable under 103(a) over Klein in view of Fuks. Claims 1 and 14 have been amended herein. No new matter has been added. Each of the pending claims is believed to now be in condition for allowance. Reconsideration of all claims is respectfully requested.

If any informalities remain which can be addressed by Examiner's Amendment, Applicant request that the undersigned by contacted in order to expedite the present application.

Respectfully submitted,

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